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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/833,986 | 04/12/2001 | Yong Chang | 678-649 (P9792) | 2092 |
| 28249 | 7590 | 05/03/2006 | EXAMINER | |
| DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553 | | | FOX, JAMAL A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2616 | |

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/833,986

Applicant(s)

CHANG, YONG

Examiner

Jamal A. Fox

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 4-7.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 03/03/2006 have been fully considered but they are not persuasive. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnamurthi et al. (U.S. Patent No. 6,134,434) in view of Krishnamurthi et al. (U.S. Patent No. 6,198,929). Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishnamurthi et al. (U.S. Patent No. 6,198,929).

Applicant argued that several of the limitations of the rejected claims are not taught or suggested by the prior art. However, one skilled in the art would recognize that all of the limitations are taught or suggested by Krishnamurthi et al. (U.S. Patent No. 6,134,434) in view of Krishnamurthi et al. (U.S. Patent No. 6,198,929).

Applicant argued that Krishnamurthi et al. (U.S. Patent No. 6,134,434) does not disclose creating a new service type identifier and a new service configuration record, which are used to indicate that the target BS can provide one of the previous services to the MS, and are used by the MS to connect to the target BS. Applicant also argued that these defects are not cured by Krishnamurthi et al. (U.S. Patent No. 6,198,929). However, referring to claim 1, Krishnamurthi et al. (U.S. Patent No. 6,134,434) discloses a method for performing a handoff (handoff, col. 9 line 55 - col. 10 line 6) including a first base station (BS1 108, col. 9 line 55 - col. 10 line 6) communicating voice and packet data (voice, data, col. 3 lines 9-18) with a mobile station (SU1 112, col. 9 line 55 - col. 10 line 6), a mobile switching center (MSC 102, col. 9 line 55 - col. 10 line 6) connected to the first base station (BS1, Figures 3 and 4) and a second base station

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(BS2 110, col. 9 line 55 - col. 10 line 6) adjacent to the first base station (BS1, Figures 3 and 4), the method comprising the steps of:

sending (sends, col. 9 lines 57-58) a handoff required message from the first base station to the mobile switching center, the handoff required message including a service configuration record (service configuration, col. 9 lines 57-60);

sending (sends, col. 9 lines 60-62) from the mobile switching center the service configuration record of the received handoff required message to the second base station;

determining (processing, col. 9 lines 62-64) in the second base station whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type identifier and a new service configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible;

sending (returns, col. 9 lines 64-66) from the mobile switching center the new service type identifier and the new service configuration record to the first base station; but does not explicitly teach of including a service type identifier indicating a concurrent service of the voice and packet data, sending from the first base station the new service type identifier and forming in the mobile station a communication link (link, col. 5 lines 36-48) to the second base station according to the new service configuration record.

However, voice and packet data are disclosed in Krishnamurthi et al. (U.S. Patent No. 6,198,929) (voice and SMS messages, col. 2 lines 55-59, col. 3 lines 15-34, col. 7 lines

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49-58, col. 8 lines 8-17, col. 8 lines 36-53, col. 8 line 65-col. 9 line 8, col. 9 lines 10-23, col. 9 line 66-col. 10 line 16 and col. 11 lines 10-22), and the Service Configuration Directive contains the service configuration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the service type identifier indicating a concurrent service of the voice and packet data of Krishnamurthi et al. (U.S. Patent No. 6,198,929) to the invention of Krishnamurthi et al. (U.S. Patent No. 6,134,434), in order to maintain the service connection by allowing both calls as suggested by Krishnamurthi et al. (U.S. Patent No. 6,198,929).

2. Applicant argued that Krishnamurthi et al. (U.S. Patent No. 6,198,929) makes no disclosure of the presently claimed limitation of performing a handoff concurrently transmitting voice and packet data. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argued that Krishnamurthi et al. (U.S. Patent No. 6,198,929) would not make recognition that radio resource information is an SMS message. However, one skilled in the art would recognize that radio resource information which is the SMS message and a service type identifier, which is part of the configuration record, are both disclosed in Krishnamurthi '929 (col. 3 lines 9-55).

3. Applicant argued that the examiner incorrectly reasons that since voice and packet data are disclosed in Krishnamurthi et al. (U.S. Patent No. 6,198,929), and the

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Service Configuration Directive allegedly contains the service configuration, then it would have been obvious to include a service type identifier indicating a concurrent service of voice and packet data in Krishnamurthi et al. (U.S. Patent No. 6,134,434). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argued that there is no recitation in either Krishnamurthi et al. (U.S. Patent No. 6,134,434) or Krishnamurthi et al. (U.S. Patent No. 6,198,929) of the second base station determining whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, and sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type identifier and a new service configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible. However, one skilled in the art would recognize that determining in the second base station whether it is possible to communicate with the mobile station using a radio resource specified in the service type identifier and the service configuration record, sending, when it is not possible to communicate with the mobile station, to the mobile switching center a new service type

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identifier and a new service configuration record indicating that communicating with one of the voice and packet data with the mobile station is possible is disclosed in (col. 9 lines 62-64 of Krishnamurthi et al. (U.S. Patent No. 6,134,434)) and (col. 10 lines 1-16 of Krishnamurthi et al. (U.S. Patent No. 6,198,929)).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamal A. Fox whose telephone number is (571) 272-3143. The examiner can normally be reached on 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamal A. Fox


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